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BRIDGESTONE AMERICAS, INC. 10 East Firestone Blvd. AKRON, OH 44317			DYE, ROBERT C	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JON I. STUCKEY, KATHLEEN CLEMMER, DAVID JOHNSON, JACOB LEE WALTERS, MICHAEL A. BERZINS, WILBUR EUGENE HOLMES, TODD ALAN BUXTON, KENT DAVID WEATHERWAX, and AUTUMN T. KAHWAJI

Appeal 2019-004757
Application 13/954,249
Technology Center 1700

Before ROMULO H. DELMENDO, KAREN M. HASTINGS, and JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ requests our review under 35 U.S.C. § 134(a) of the Examiner's decision rejecting claims 1, 2, 5, 7–12, 16, and 18–22 under 35 U.S.C. § 112 as lacking written description support. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

¹ We use the word “Appellant” to refer to the “Applicant” as defined in 37 C.F.R. § 1.42(a). Appellant is Bridgestone Americas Tire Operations, LLC, which is also identified as the real party in interest (Appeal Br. 1).

We AFFIRM.

CLAIMED SUBJECT MATTER

Claim 1 is illustrative of the subject matter on appeal (emphasis added to highlight key disputed limitation):

1. A tire comprising:
 - a pair of sidewalls;
 - a circumferential tread constructed of a base rubber, the circumferential tread having a plurality of grooves disposed therein, thereby defining a plurality of tread elements, wherein at least one of the plurality of tread elements includes a sipe;
 - and
 - a polymeric laminate disposed on the circumferential tread,
 - wherein the polymeric laminate covers at least one of the plurality of grooves,
 - wherein the polymeric laminate covers a top surface of at least one of the plurality of tread elements,
 - wherein the polymeric laminate covers the sipe, *such that the sipe is not visible when the tire is new,*
 - wherein the polymeric laminate is configured to wear off of the top surface of the at least one of the plurality of tread elements during the life of the tire, and
 - wherein the polymeric laminate has greater snow traction than the base rubber.

Independent claims 12 and 19 also each recite a tire having a polymeric laminate that covers sipes in the tire, such that the sipes are not visible when the tire is new (Claims Appendix 18, 19).

ANALYSIS

Upon consideration of the evidence of record and each of Appellant's contentions as set forth in the Appeal Brief, as well as the Reply Brief, we determine that Appellant has not demonstrated reversible error in the Examiner's rejections (*e.g., generally Ans.*). *In re Jung*, 637 F.3d 1356,

1365–66 (Fed. Cir. 2011) (explaining the Board’s long-held practice of requiring Appellant(s) to identify the alleged error in the Examiner’s rejection.). We sustain the rejection for the reasons expressed by the Examiner in the Final Office Action and the Answer.

We add the following primarily for emphasis.

Independent claims 1, 12, and 19 each recite that the laminate covers at least some sipes such that the sipe(s) are “not visible when the tire is new.” The Examiner finds the originally-filed application does not contain written description support for this limitation. Final Act. 2.

The written description “must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (citation and quotations omitted, alteration in the original). The test is whether the disclosure “conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.*

As explained in *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997) (emphasis added),

[t]o fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that “the inventor invented the claimed invention.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (“[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”). Thus, an applicant complies with the written description requirement “by describing the invention, with all its claimed limitations, *not that which makes it obvious*,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc.,

that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

Appellant contends that paragraph 24 of the originally-filed application describes that the laminate may have a thickness of 1.0 to 1.5 mm, paragraph 55 of the originally-filed application describes that the laminate may be applied using a vacuum process, sipes are known to range in size from 0 to 5 mm, and therefore one of ordinary skill in the art would have recognized that the laminate of the described invention may cover the sipes such that they are not visible when new (that is, when a vacuum process is used and the sipe size is smaller than the thickness of the laminate) (Appeal Br. 13–15; Reply Br. 2–4).

The Examiner correctly states that the Specification fails to describe any specific sizes for the sipes, fails to describe that the sipes are not visible when the tire is new, describes that the laminate may be thicker or thinner than 1.5mm, and describes numerous processes that may be used to apply the laminate (Ans. 4). The Examiner also points out that Appellant has not provided any credible evidence that a vacuum process would indeed inherently result in a laminate that would cover the sipes such that they are not visible when the tire is new (*id.*).

We agree with the Examiner that the Appellant is now claiming a negative limitation, that is, the sipes are not visible when the tire is new (Ans. 5). We do not find, however, nor does Appellant identify, a disclosure in the Specification that properly describes using a laminate to cover sipes such that they are not visible when the tire is new. *Santarus, Inc. v. Par Pharm., Inc.*, 694 F.3d 1344, 1350–51 (Fed. Cir. 2012) (“Negative claim limitations are adequately supported when the specification describes a

reason to exclude the relevant limitation.” In *Santarus*, the court found that claims reciting the negative limitation “wherein the composition contains no sucralfate” satisfied the written description requirement, because the specification described sucralfate as having adverse effects and described omeprazole as an advantageous alternative.).

Furthermore, the test is not whether one of ordinary skill in the art would find the invention obvious after reading the disclosure, it is whether the disclosure itself conveys that Appellant had possession of the later-claimed subject matter. A disclosure that merely renders the later-claimed subject matter obvious is not sufficient to meet the written description requirement; the disclosure must describe the claimed invention with all its limitations. *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998); *Lockwood*. “That a person skilled in the art might realize from reading the disclosure that such a step is *possible* is not a sufficient indication to that person that the step is part of appellants’ invention.” *In re Barker*, 559 F.2d 588, 593 (CCPA 1977) (quoting *In re Winkhaus*, 527 F.2d 637, 640 (CCPA 1975)).

In sum, Appellant has not persuaded us of reversible error in the Examiner’s determination that the originally-filed application does not provide written description support for a tire with sipe(s) that are covered by a laminate such that the sipes are not visible when the tire is new, as urged by Appellant (Reply Br. 1).

Accordingly, we sustain the rejection of all the claims under 35 U.S.C. § 112 for lack of written description.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1, 2, 5, 7-12, 16, 18-22	§ 112	Lack of Written Description	1, 2, 5, 7-12, 16, 18-22	

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED